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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,775	08/26/1999	MARC IRA LIPTON	A00404-1	7026

757 7590 08/18/2003

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EXAMINER

SWERDLOW, DANIEL

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/383,775

Applicant(s)

LIPTON ET AL.

Examiner

Daniel Swerdlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 16 June 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 46 through 49, 52, 53, 55 through 58, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorman et al. (US Patent 4,497,980) in view of Shenk (US Patent 2,561,950).

4. Claim 46 claims a method comprising providing a telephone apparatus having a handset, a handset-receiving portion and a hands-free audio interface. Gorman discloses an apparatus that corresponds to the telephone apparatus claimed and has a handset (Fig. 1, reference HANDSET), a hook (column 2, lines 53-56) that corresponds to the handset-receiving portion claimed, and a handsfree capability (column 1, lines 58-61) that corresponds to the hands-free audio interface claimed. Claim 46 further claims the method comprises communicating audio input and output of a telephone call via the hands-free audio interface while the handset is received by the handset-receiving portion. Gorman discloses a handsfree mode operable when the handset is on hook (i.e., received by the handset-receiving portion) (column 2, lines 57-63). Claim 46 further

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claims muting the audio input and maintaining the audio output in response to the handset being removed from the handset-receiving portion. Gorman discloses a manual microphone switch (Fig. 3, reference MIC; column 4, lines 50-54) that, when closed, mutes the transmit path (i.e., the audio input) while not affecting the receiving path (i.e., the audio output). Therefore, Gorman anticipates all elements of Claim 46 with the exception of muting the audio output in response to the handset being removed from the handset-receiving portion. Shenk discloses a switch (Fig. 14, reference 94, 95, 96; column 5, lines 38-44) closed by removal of a telephone handset. It would have been obvious to one skilled in the art at the time of the invention to apply handset position-based actuation as taught by Shenk to the manual microphone switch in the apparatus taught by Gorman for the purpose of reducing the number of switches required on the manual inputs portion of the apparatus.

5. Claim 47 claims the method of Claim 46 further comprising unmuting the audio input in response to the handset being replaced. As stated above apropos of Claim 46, the combination of Gorman and Shenk meets all elements of that claim. In addition, the manual microphone switch disclosed by Gorman unmutes the transmit path when opened and the switch disclosed by Shenk opens when the handset is replaced. Therefore the combination meets all elements of Claim 47.

6. Claim 48 is essentially similar to Claim 46 and is rejected for the reasons stated above apropos of Claim 46.

7. Claim 49 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

8. Claim 52 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

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9. Claim 53 is essentially similar to Claim 49 and is rejected for the reasons stated above apropos of Claim 49.

10. Claim 55 is essentially similar to Claim 46 and is rejected for the reasons stated above apropos of Claim 46.

11. Claim 56 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

12. Claim 57 is essentially similar to Claim 48 and is rejected for the reasons stated above apropos of Claim 48.

13. Claim 58 is essentially similar to Claim 49 and is rejected for the reasons stated above apropos of Claim 49.

14. Claim 61 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

15. Claim 62 is essentially similar to Claim 49 and is rejected for the reasons stated above apropos of Claim 49.

16. Claims 50, 51, 54, 59, 60 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erving (US Patent 4,901,346) in view of Gorman and further in view of Shenk.

17. Claim 50 claims a computer-readable storage medium containing data to direct an apparatus to perform a method as described in Claim 46. Gorman discloses a computer controlled speakerphone (Fig. 1, reference 100; column 3, lines 53-55) that uses programming (i.e., data to direct the apparatus) to perform speakerphone functions and inherently includes a

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memory that corresponds to the computer-readable storage medium claimed. Therefore, Gorman anticipates all elements of Claim 50 with the exception of performing a method as described in Claim 46. As stated above apropos of Claim 46, the combination of Gorman and Shenk teaches that method. It would have been obvious to one skilled in the art at the time of the invention to apply handset position control of the mute function as taught by the combination of Gorman and Shenk to the computer controlled speakerphone taught by Erving for the purpose of controlling the manual mute function.

18. Claim 51 claims the medium of Claim 50 further directing the apparatus to perform a method as described in Claim 47. As stated above apropos of Claim 50, the combination of Gorman, Shenk and Erving teaches all elements of that claim. In addition, as stated above apropos of Claim 47, the combination of Gorman and Shenk teaches that method. Therefore, the combination of Gorman, Shenk and Erving teaches all elements of Claim 51.

19. Claim 54 is essentially similar to Claim 51 and is rejected for the reasons stated above apropos of Claim 51.

20. Claim 59 is essentially similar to Claim 50 and is rejected for the reasons stated above apropos of Claim 50.

21. Claim 60 is essentially similar to Claim 51 and is rejected for the reasons stated above apropos of Claim 51.

22. Claim 63 is essentially similar to Claim 51 and is rejected for the reasons stated above apropos of Claim 51.

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23. Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorman in view of Shenk as applied to Claim 46 above and further in view of Yamamoto et al. (US Patent 5,572,575).

24. Claim 64 claims the method of Claim 46 further comprising communicating a second audio input via the handset. As stated above apropos of Claim 46, the combination of Gorman and Shenk makes obvious all elements of that claim. Therefore, the combination makes obvious all elements of Claim 64 with the exception of communicating a second audio input via the handset. Yamamoto discloses a speakerphone that accepts audio input simultaneously from the speakerphone base unit and the handset microphone (Fig. 3; column 9, lines 43-47). It would have been obvious to one skilled in the art at the time of the invention to apply three-way communication as taught by Yamamoto to the combination made obvious by Gorman and Shenk for the purpose of allowing communication among the handset, base and an external party.

25. Claim 65 claims the method of Claim 64 further comprising communicating a second audio output via the handset. As stated above apropos of Claim 64, the combination of Gorman, Shenk and Yamamoto makes obvious all elements of that claim. Further, Yamamoto discloses a speakerphone that provides audio output simultaneously from the speakerphone base unit and the handset speaker (Fig. 3; column 9, lines 43-47). Therefore, the combination makes obvious all elements of Claim 65.

Response to Arguments

26. Rejections made in the Office action mailed on 14 March 2003 are repeated above for convenience. No new grounds for rejection of unamended claims have been added.

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27. Applicant's arguments filed 16 June 2003 have been fully considered but they are not persuasive.

28. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

29. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., handset activation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims are directed to muting and unmuting a hands-free audio interface controlled by handset placement.

30. Applicant alleges that Gorman teaches against "[r]elocating the MIC switch" because Gorman teaches separation of the voice switching circuit and the handset hook switch. Examiner respectfully disagrees. The combination of Gorman and Shenk does not require an interconnection between the hook switch of Gorman and the voice switching circuit of Gorman because Shenk teaches a separate switch physically operated by the placement of the handset.

31. Applicant alleges that combining the speakerphone disclosed by Gorman with the handset operated switch disclosed by Shenk would "greatly increase the amount and complexity of circuitry" and that the references "do not disclose or suggest the new circuitry and switches required". Examiner respectfully disagrees. The combination of Gorman and Shenk requires

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only the substitution of the handset placement operated switch taught by Shenk for the MIC switch taught by Gorman with no additional components and no changes in circuitry.

32. Applicant alleges that the combination of Gorman and Shenk has less utility than the device taught by Gorman alone. Examiner respectfully disagrees. The simplification of the manual input section of the speakerphone adds utility to the device taught by Gorman.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Swerdlow whose telephone number is 703-305-4088. The examiner can normally be reached on Monday through Friday between 8:00 AM and 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forrester Isen can be reached on 703-305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ds
August 12, 2003


XU MEI
PRIMARY EXAMINER